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10/791,996	03/03/2004	Carmen Flosbach	FA1013 US DIV	4286

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/791,996

**Applicant(s)**

FLOSBACH ET AL.

**Examiner**

Elena Tsoy

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11,12 and 16-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 11,12 and 16-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

Amendment filed on February 8, 2005 has been entered. Claims 13-15 have been cancelled. Claims 11-12, 16-21 are pending in the application.

***Claim Objections***

1. Objection to claim 19 because of the informalities has been withdrawn due to amendment.

***Specification***

2. The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: cycloaliphatic polyols having 3-6 hydroxyl groups of Claim 17 are not in the body of the disclosure. Polyols recited on page 3, lines 8-13 of the specification as filed such as glycerol, trimethylolpropane, pentaerithrytol, etc. are not cycloaliphatic polyols. Amendment of the disclosure to incorporate the language of originally filed claims does not raise issue of new matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al (US 4,880,890) has been withdrawn due to amendment.

6. Rejection of claims 12, 13, 16, 18-21 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miyabayashi et al (US 4,880,890) has been withdrawn due to amendment.

7. **Claims 11-12, 16, 18-21** stand rejected under 35 U.S.C. 102(b) as being anticipated by Duecoffre et al (US 6,063,448) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on August 3, 2004.

8. **Claim 11** is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Duecoffre et al (US 6,063,448) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on August 3, 2004 because claim 11 is amended to insert limitations of claims 14 and 15.

9. **Claims 11, 12, 16, 18-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al (US 4,880,890) in view of Willey (US 5,023,141) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on August 3, 2004 because claims 11 and 12 are amended to insert limitations of claims 14 and 15.

10. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Duecoffre et al (US 6,063,448) in view of JP 08239458 (Abstract) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on August 3, 2004 because claim 12 is amended to insert limitations of claims 14 and 15.

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11. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyabayashi et al (US 4,880,890) in view of JP 08239458 (Abstract) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on August 3, 2004 because claim 12 is amended to insert limitations of claims 14 and 15.

***Response to Arguments***

12. Applicants' arguments filed February 8, 2005 have been fully considered but they are not persuasive.

(A) Applicants respond that the terminology "cycloaliphatic polyols" is well known to those in the art, wherein this terminology describes either a cycloaliphatic polyol or an aliphatic polyol. Additionally, it is well known in the art that glycerol is an aliphatic polyol, and thus, Applicants believe that the present specification does provide adequate antecedent basis for the claimed subject matter. Accordingly, Applicants have submitted herewith U.S. Patent 6,368,719 (Siever et al.) as evidence that such terminology is well known in the art, where Siever et al. utilize the term "cycloalkylmethacrylates" (see column 4, lines 29-37), where several representative compositions are provided.

The Examiner respectfully disagrees with this argument. In contrast to Applicants' statement, cycloaliphatic polyol has to have a **ring** structure, as evidenced by Merriam-Webster's Collegiate Dictionary, US 6,451,928 to Ambrose et al (See column 4, lines 10-24) and US 4,070,509 to Garner et al (See column 1, lines 56-57). However, examples of cycloaliphatic polyol given in the specification as filed do not include any cycles. Therefore, they are not cycloaliphatic polyols.

(B) Applicants believe that Duecoffre teaches away from the present invention because Duecoffre's clear coat does not contain a polyester polyol (a) of present invention, but instead

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contains a hybrid binder comprising polyester polyol as one part in which the second part (i.e. the (meth)acrylic copolymer portion) has been prepared by free-radical polymerization.

The Examiner respectfully disagrees with this argument. Duecoffre's clear coat does contain 80 wt % -60 wt % or less of a polyester polyol (a) of present invention, **in addition** to a hybrid binder comprising e.g. **at least** 20 wt % -40 wt % polyester polyol as one part in which the second part (i.e. the (meth)acrylic copolymer portion) has been prepared by free-radical polymerization (See Abstract; column 1, lines 61-67; column 2, lines 23-36). Moreover, claims 11 and 12 do not recite negative limitation about a hybrid binder, i.e. the hybrid binder is not excluded from the composition of claims 11 and 12.

(C) Applicants believe that Duecoffre teaches away from the present invention in that the polyester polyol of the present invention is non-aromatic. Duecoffre teaches that aromatic acids as polyester constituents are suitable for use, for example in column 6, lines 18-28 which describes the use of isomeric phthalic acids and 1,4-**cyclohexanedicarboxylic** acid. The use of such acids is clearly not permitted in the present invention as is set forth in Claim 11, part (a) and Claim 12, part (a).

First of all, in contrast to Applicants' statement, the use of such acids is clearly permitted in the claimed invention as is set forth in Claim 11, part (a) and Claim 12, part (a) because they do not recite negative statement. Secondly, cyclohexanedicarboxylic acid is not aromatic. Thirdly, Duecoffre teaches both aromatic acids and non-aromatic acids. It is held that patents are relevant as prior art for **all** they contain. See MPEP 2123.

(D) Applicants believe that Duecoffre teaches away from the claimed quantitative composition of components (a1) and (a2) of the present invention, which require that the hydroxyl

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components and carboxyl components comprise no more than 20 wt-o/o of at least one diol and at least one monocarboxylic acid, respectively. To the contrary, Example 1 of Duecoffre comprises 57.8 M-o/o of monocarboxylic acid (isononanoic acid) among the carboxyl components and Example 2 of Duecoffre comprises 57 wt-% diol (hexane diol) among the hydroxyl components. In these Examples, both values (the 57.8 M-% and 57 wt-%) are far above the upper limit disclosed in the present invention, which is 20 wt-% in either case. This upper limit is set at 20 M-% to ensure the high level of hydroxyl-functionality of the final polyester of the present invention.

However, Duecoffre does teach that 0 to 40 wt % of diols, and 0 to 60% wt % of monocarboxylic acids (which cover claimed ranges) are used for preparing polyester polyols (See column 14, lines 40-65). Moreover, it is held that PATENTS ARE RELEVANT AS PRIOR ART FOR *ALL* THEY CONTAIN. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP 2123.

(E) Applicants do not believe that the combination of Miyabayashi with Willey teaches or suggests the present invention. The present invention utilizes a color-imparting and/or special effect-imparting base coat while Willey is directed to a primer composition and such compositions are not generally interchangeable.

The Examiner respectfully disagrees with this argument. Willey teaches that a polyester primer can be used as color-imparting base coat. Therefore, the combination of Miyabayashi with Willey teaches the claimed invention.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-141523. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy  
Primary Examiner  
Art Unit 1762

April 5, 2005

ELENA TSOY  
PRIMARY EXAMINER  
*ETsoy*